

REMARKS

This application includes pending claims 80-86, 89-98, 101-110 and 113-115. By this amendment, claims 80, 92, 93, 96-98 and 101-105 are amended and claims 87-88, 99-100 and 111-112 are canceled.

The Office Action indicates that the Examiner has requested the Applicant to identify where in the prior applications the features of the present invention are first disclosed, and gives an example that in the priority document, the Applicant does not mention data subject and data recipient. The Office Action then asserts that claims addressed to these entities are accorded the filing date of the instant application, April 27, 2000.

It is respectfully asserted that the Examiner has improperly asserted that the present application is entitled to only the filing date of the present application. As indicated in MPEP 201.09, unless the filing date of an earlier application is actually needed to overcome a reference, there is no need for the office to make a determination as to whether the earlier application discloses the invention in a continuation-in-part situation. The MPEP indicates that an alleged continuation-in-part application should be allowed to claim the benefit of the earlier application if there is a common inventor, the applications were co-pending and the continuation-in-part application contains a reference to the earlier filed application. These requirements have been met, and the Peckover and Walker references asserted against the claims do not have effective dates that raise an issue as to whether the filing date of the parent application is needed.

Further, even if the references were intervening references, before concluding claims of the present application are not entitled to the filing date of the parent application, the Examiner would have to make a finding that the claims of the application are not supported by the specification of the parent application. Moreover, as indicated in the MPEP, the present situation does not make such a determination necessary. Applicants have not made an analysis of this issue, and do not intend on doing so unless an intervening reference showing the claimed invention is applied, and the Examiner asserts on the record that certain claimed features are not

present. It is asserted that it is improper for the Examiner to require Applicants to point out support in the parent application for certain claimed features when there is no intervening reference being applied, and applicants request that the Examiner withdraw the unsupported statement that the claims are only entitled to the April 27, 2000 filing date.

The Office Action objects to the drawings under 37 CFR 1.83(a), asserting that every feature specified in the claims must be shown in the drawings. This objection is respectfully traversed.

The purchase query is shown in, for example, Fig. 2C in conjunction with item 240, present offer, which is a purchase query presented to the data subject. The purchase reply is shown, for example, in conjunction with item 248, where the data subject decides whether to buy the item, and selects either yes or no, which constitute the purchase reply. Regarding claims reciting summaries, these claims have been canceled.

The Office Action rejects the pending claims under the judicially-created doctrine of obviousness-type double patenting over claims 1-123 of US Pat 6,092,053 to Boesch. Attached hereto is a terminal disclaimer regarding the '053 patent.

The Office Action rejects claims 80-91 and 92-103 under 35 USC 101. This rejection is respectfully traversed.

Claims 80 and 92 now recite a computer network, a data subject network communication device and a data repository computer. Applicants believe that these claims recite statutory subject matter under 35 USC 101 that is within the technological arts. Withdrawal of the rejection is requested.

The Office Action rejects claims 92-103 under 35 USC 112, second paragraph. This rejection is respectfully traversed.

Regarding claims 92-103, certain of these claims have been amended to no longer recite method steps. Regarding claims 82, 85, 94, 97, 106 and 109, applicants do not understand the rejection and believe that the claims are definite as recited. Regarding claim 107, it is asserted that the purchasing information may be associated with the data subject network communication device software, as well as with the data subject.

Regarding the term “offer”, the specification at page 12, for example, discusses items that may be included in an offer in the context of a computer transaction, as referenced in the office action. The Examiner’s reference to a dictionary is inappropriate, as such a dictionary definition is general, and not in the context of a computer transaction. Further, the Federal Circuit sitting en banc in Edward H. Phillips v. AWH Corp., 03-1269, -1286 (Fed. Cir., July 2005) has cautioned against the improper use of dictionaries, and refers to the improper use of general dictionaries. The court emphasizes the importance of the specification in interpreting the claims.

Further, the Examiner incorrectly refers to Applicants “new definition” being different from the terms definition in the specification, specifically referring to the Applicants statement that:

“The offer as claimed must be: (1) received from a data subject (a first party) and (2) associated with a data recipient (a second party).”

This is certainly not a definition of the recited term “offer” as asserted by the Examiner, but is instead merely pointing out that the other recitations around the term “offer” in claim 80 of “an offer associated with the data recipient and a message including a network communication device software identifier” require the offer to be (1) received from a data subject (amended to recite a data subject network communication device) and (2) associated with a data recipient (a second party), require more than just any offer.

The Office Action rejects claims 80-115 under 35 U.S.C. 103(a) over Peckover (U.S. Patent 5,119,101) in view of Walker (U.S. Patent 5,794,207). This rejection is respectfully traversed.

Independent claims 80, 92 and 104 recite a method, system or machine-readable medium for facilitating transactions over a computer network that includes receiving, from a data subject network communication device, an offer associated with a data recipient and a message including a network communication device software identifier, the offer and the message being received at a data repository computer. These claims are allowable over the prior art for at least the following reasons.

Neither Peckover nor Walker disclose or suggest includes receiving, from a data subject network communication device, an offer associated with a data recipient and a message including a network communication device software identifier, the offer and the message being received at a data repository computer. The Office Action asserts that Peckover discloses receiving from a customer an offer associated with a merchant. The Office Action does not assert where Peckover allegedly discloses this feature, and applicants request a specific citation. The Examiner is apparently asserting that in Peckover an offer is received from a consumer, where the offer was created by a merchant. Applicants do not believe that Peckover contains any such disclosure.

In Applicants claims, the offer is sent from the data subject network communication device and received by the data repository computer, where the offer is associated with the data recipient. The Office Action asserts that in Peckover, the offer is associated with a merchant (because it was created by the merchant), and that this offer created by the merchant is received from a customer. Peckover does not appear to disclose such an offer created by a merchant is received from a customer. While a customer may review an offer, and even accept the offer, Applicants do not see a disclosure that the offer itself is then sent from the customer. Because Peckover is missing this feature, and because Walker does not remedy this deficiency, none of the pending claims are obvious over the cited references.

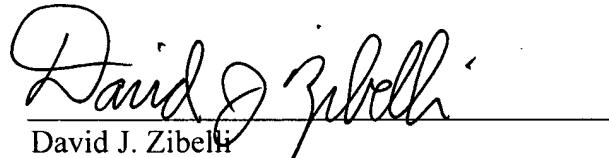
None of the three portions, or any other portions, of the references disclose or suggest the features of the independent claims. For at least these reasons, claims 80, 92 and 104 are allowable, as are all dependent claims. Withdrawal of the rejection is requested.

Because the prior art fails to teach the claimed limitations, a *prima facie* case of obviousness has not been established.

The Office is authorized to charge any fees due under 37 C.F.R. §§ 1.16, 1.17 or 1.136 to deposit account 11-0600. In view of the remarks submitted above, the Applicants respectfully submit that the present case is in condition for allowance.

Should the Examiner have any questions concerning this matter, he is invited to contact Applicants' undersigned attorney at 202/220-4334.

Respectfully submitted,



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